



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/787,624

07/15/2003

Paolo Pirazzoli

02508.0087

4701

22852

7590

08/28/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

DEAK, LESLIE R

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/787,624	PIRAZZOLI ET AL.	
	Examiner	Art Unit	
	Leslie R. Deak	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2006.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. PCT/IB00/01069.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on 1 June 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,730,233 and US 6,966,979 has been reviewed and is NOT accepted.
2. An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-4 and 6-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7-10 of U.S. Patent No. 6,730,233 to Pedrazzi. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims present a dialysis machine with a "means for" carrying out the method claimed in the instant application. Therefore, the machine in the patent not only is capable of performing the claimed method, but actually does so. Therefore, the instant application is unpatentable over the claims of the previously patented invention.

With regard to claim 15, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place additional pumps in the device claimed by Pedrazzi, since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. See MPEP § 2144.04.

5. Claims 5, 16, and 17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,730,233 to Pedrazzi in view of US 6,471,872 to Kitaevich et al, as applied above. Pedrazzi claims a machine with "means for" performing the method as claimed in the instant application, with the exception of checking whether the filtration factor is below a predetermined value. Kitaevich discloses that in his method, the calculator/controller constantly compares measured values to predetermined values to ensure that the device is operating within predetermined safe parameters. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the checking step to the device with "means for" performing the claimed method as claimed by Pedrazzi in order to ensure safe operating parameters, as taught by Kitaevich.

6. Claims 9, 11, and 12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4, 5 of U.S. Patent No. 6,966,979 to Pedrazzi. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented invention includes all the components of the instantly claimed device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to remove the components of the patented device (such as the dilution pipes) in order to create the instantly claimed device, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. See MPEP § 2144.04.

Allowable Subject Matter

7. The pending claims are rejected under a double patenting rejection (see above), but would be allowable with a properly filed Terminal Disclaimer.

8. The following is an examiner's statement of reasons for indicating allowable subject matter: The prior art fails to disclose or suggest the device and method claimed by applicant. In particular, the prior art fails to disclose or suggest a method for controlling a dialysis machine comprising the steps of providing a two-compartment filter, connecting the fluid lines and circulating fluid as claimed, determining the value of a first parameter associated with the liquid flow in the first compartment, determining the claimed value of a second parameter of the fluid, calculating a filtration factor as a function of the first and second parameter, and controlling fluid flow as a function of the calculated filtration factor.

The best prior art of record, US 6,471,782 to Kitaevich, discloses measuring and calculating parameters of fluid flowing through a dialysis system, but fails to disclose the steps of calculating a third parameter based on the measured values of first and second parameters and controlling fluid flow based on the third parameter, as claimed by applicant.


Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie R. Deak whose telephone number is 571-272-4943. The examiner can normally be reached on M-F 7:30-5:00, every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Leslie R. Deak
Patent Examiner
Art Unit 3761
18 August 2006

TATYANA ZALUKAEVA
SUPERVISORY PRIMARY EXAMINER

